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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,272	11/15/2001	Jeffrey B. Hoke	4569A(DIV)	3733

7590 06/10/2005

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EXAMINER	
TRAN, HIEN THI	
ART UNIT	**PAPER NUMBER**
1764	

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/002,272	HOKE ET AL.	
	Examiner	Art Unit	
	Hien Tran	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *37-53 and 55-58* is/are pending in the application.

4a) Of the above claim(s) *37-47* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *48-53 and 55-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *37-53 and 55-58* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 48-53, 55-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 48, line 3 it is unclear as to how the ambient air is related to the atmosphere set forth in line 1.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 48-53, 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/02235 in view of JP 52-122290.

WO 98/02235 discloses a motor vehicle component, e.g. radiator, which is exposed to a flow of ambient air, said radiator being coated with a catalyst material of base metal, precious metal, or manganese oxide, etc.; and a protective layer of polymers (see, for example, page 2, lines 31-33; page 5, lines 23-29; page 7, line 17 to page 8, line 31; page 15, lines 24-34).

The apparatus of WO 98/02235 is substantially the same as that of the instant claims but fails to disclose whether a porous overcoat of carbon may be provided on the surface of the catalyst material.

However, WO 98/02235 recognizes that the ambient air contains pollutants, such as CO (page 2, lines 31-33).

JP 52-122290 discloses the conventionality of providing a porous layer of material, such as active carbon to cover the catalyst surface to prevent catalyst poisoning.

It would have been obvious to one having ordinary skill in the art to provide a porous overcoat of carbon material on the surface of the catalyst material as taught by JP 52-122290 in addition to the porous protective layer in the apparatus of WO 98/02235 so as to further prevent catalyst poisoning.

6. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/02235 in view of JP 52-122290 as applied to claims 48-53, 56-58 above and further in view of Hoke et al (6,190,627).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to select an appropriate material for the protective material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of

its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In any event, Hoke et al discloses that the protective material is selected from the group of fluoropolymers or silicone polymers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to alternately select an appropriate material for the protective material, such as the ones taught by Hoke et al, for the known and expected results of obtaining the same results by different means in the absence of unexpected results.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 48-53, 55-58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-19 of U.S. Patent No. 6,190,627 in view of JP 52-122290.

Claims 9-19 of U.S. Patent No. 6,190,627 disclose a motor vehicle component, e.g. radiator, coated with a catalyst material of base metal, precious metal, or manganese oxide, etc.; a hydrophobic protective layer of fluoropolymers or silicone polymers; and a porous overcoat of

material to prevent the catalyst degrading pollutants from contacting the catalyst, but are silent as to whether the overcoat material may be carbon.

The same comments with respect to JP 52-122290 apply.

Response to Arguments

9. Applicant's arguments filed 3/14/05 have been fully considered but they are not persuasive.

Applicants argue that the instant specification establishes the relationship between the ambient air and the atmosphere. However, it should be noted that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *in re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is suggested that the claim should be amended to clarify the relationship between the ambient air and the atmosphere.

Applicants argue it would be no incentive for one of ordinary skill in the art to substitute the activated carbon adsorptive material of JP '290 for the plastic material of WO '235 (Dettling) since Dettling seeks to repel particulate and liquid contaminants emanating from roadways with the non-adsorptive plastic overcoat while JP '290 uses an adsorptive material. Such contention is not persuasive as Dettling teaches protecting the catalyst by using a plastic material overcoat. One of ordinary skill in the art would be led to other types of material for protecting the catalyst. Protecting the catalyst is a common problem to be solved, not the fact that one reference seeks to repel the contaminants and the other deals with the adsorptive material.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

WO 96/22146, WO 96/22150 and WO 97/11769 are cited for showing state of the art.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hien Tran whose telephone number is (571) 272-1454. The examiner can normally be reached on Tuesday-Friday from 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hien Tran

HT

Hien Tran
Primary Examiner
Art Unit 1764